

**REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-2 and 5-16 are currently pending in this application. Claims 3-4 have been cancelled. No new matter has been added by way of the present amendment. For instance, the amendment to claim 1 is supported by, for example, previously presented claims 3 and 4. New claims 13-16 are supported by the Specification at, for example, page 14. Other amendments to the claims are merely editorial in nature to better conform the language of the claims to U.S. practice. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

**Election/Restrictions**

The Examiner maintains the Restriction Requirement issued on May 4, 2007. Applicants respectfully traverse.

In response to our previous arguments, the Examiner asserts that the prior art discloses the claimed compounds, that there would be a serious burden on the Examiner were he to examine all groups, that there is no overlapping material and that rejoinder is unapplicable because the product is not novel.

Applicants initially note that the Examiner has not addressed Applicants' previous arguments with regard to Unity of Invention. The Examiner is respectfully reminded that, under Unity of Invention standards, "...in addition to an independent claim for a given product, an

independent claim for a process specially adapted for the manufacture of said product and an independent claim for the use of said product [is permitted]..." (see Unity of Invention Rule (e)(i), Annex B). Thus, under Unity of Invention standards, Applicants are entitled to at least the subject matter of Groups III, VI and VIII, along with the subject matter of Group II.

Furthermore, Applicants submit that the outstanding restriction requirement is improper, as it contains two groups (Groups I and II) which are directed to the same claims. Under U.S. patent laws, when a claim recites a multiplicity of species, the proper procedure is to initiate an Election of Species Requirement, and not a Restriction Requirement. Furthermore, a provisional election of species is proper when the generic claim recites "such a multiplicity of species that an unduly extensive and burdensome search is necessary" (see MPEP 806.02). In the instant case, the two presently claimed species (claim 1) do not represent "such a multiplicity of species". Furthermore, there is a linking concept between the two groups, as the ring structures are formed from the hydrazide structures by a ring close reaction (*see* Examples Section in the present Specification).

Applicants respectfully request withdrawal of the outstanding restriction requirement and examination of all presently pending claims.

**Issues Under 35 U.S.C. §103(a)**

Claims 1-3, 5 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Grote et al. (Grote '753). Applicants respectfully traverse.

The Examiner asserts that Grote '753 discloses a core structure and compounds which would render claims 1-3 and 5 obvious. Specifically, the Examiner asserts that the only

distinction between the compounds disclosed by Grote '753 and the presently claimed compound is the presence of an oxo group attached at the 5-position of the pyrazole and the triazole. The Examiner asserts that it would have been obvious to one skilled in the art to modify the compound disclosed by Grote '753 "with a reasonable expectation of success of obtaining compounds with analogous properties".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Grote '753 does not teach or suggest each and every limitation of the present invention. For instance, Grote '753 fails to disclose the specific substituent group R<sup>4</sup> presently claimed. As disclosed by Grote '753 at page 3, lines 23-24, the invention of Grote '753 only encompasses

**heteroaryl-substituted pyrimidines** (emphasis added). In stark contrast, the present invention requires a pyrazolone group R<sup>4</sup> that is not aromatic, but is rather a partially unsaturated heterocyclic compound. Grote '753 fails to teach or suggest such a compound.

Furthermore, Applicants submit that the Examiner has not provided a reasonable basis to modify Grote '753. Although Grote '753 discloses fungicidal pyrimidines, this reference does not disclose the specific compounds presently claimed and does not provide any basis for a motivation to one in the skilled art to change the structure of the compounds of Grote '753 to the structure of the claimed compounds.

Applicants submit that all specific compounds in Grote '753 have a heteroaryl substituent in the 2-position of the pyrimidine. Additionally, none of the heteroaryl groups carries an oxo group. One skilled in the art would not have been motivated to deviate from the teachings of Grote '753 as proposed by the Examiner. In particular, one skilled in the art would not have been motivated to make the specific selection leading to the pyrazolone compounds of the present invention. Neither the disclosure nor the claims in Grote '753 encompass the presently claimed compounds of formula (I).

Because the invention, as set forth in Applicants' claims, is not disclosed or made obvious by the cited prior art, reconsideration and withdrawal of this rejection are respectfully requested.

### **Double Patenting Issues**

Claims 1-3, 5 and 11 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7 of U.S. 7,153,860 (Grote '860). Applicants respectfully traverse.

Applicants submit that present claims 1-3, 5 and 11 are patentably distinct from claims 1-4 and 7 of Grote '860.

As previously discussed, Grote '860 (which disclosure is identical to that of Grote '753) does not teach or suggest each and every limitation of the present invention. For instance, Grote '860 fails to disclose the specific substituent group R<sup>4</sup> presently claimed, and only encompasses heteroaryl-substituted pyrimidines.

Furthermore, the Examiner has not provided a reasonable basis to modify Grote '860. One skilled in the art would not have been motivated to change the structure of the compounds of Grote '860 to the structure of the claimed compounds.

Clearly, the present claims are patentably distinct from the cited claims in Grote '860. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Claim Objections**

The Examiner asserts that claim 1 is objected to, as it contains non-elected subject matter. Applicants respectfully and strongly traverse.

Applicants submit that the Examiner's position is incorrect, and is based on an apparent misunderstanding of applicable patent rules and regulations. As discussed above (*see* "Election/Restriction" Section), the Examiner has improperly identified claim 1 as a member of two separate groups. The Examiner's mistake has caused claim 1 to belong to both an elected and a non-elected group.

Applicants respectfully submit that this objection is improper. Reconsideration and withdrawal of this objection are respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Andrew D. Meikle, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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